

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Y. MIZUNO, et al.
Application No.: 10/529,738
Filed: MARCH 30, 2005
For: RESIN COMPOSITION FOR PRINTED WIRING BOARD AND
VARNISH, PREPREG AND METAL CLAD LAMINATED
BOARD USING THE SAME
Group AU: 1796
Examiner: Robert E. Sellers
Confirm. No.: 1963

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Mail Stop: AF – NO FEE

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

January 9, 2009

SIR:

In response to the Office Action mailed October 9, 2008, Applicants respectfully maintain their traverse of the rejection of claims under 35 USC 103(a), “as being unpatentable over Mizuno et al. Patent No. 7,157,506”. Specifically, Applicants maintain their position that Patent No. 7,157,506 is disqualified as prior art under 35 USC 103. See 35 USC 103(c).

In addition, and as established infra, while the Examiner contends in Item 4 on page 3 of the Office Action mailed October 9, 2008, that the “effective filing date” for No. 7,157,506 in the publication date for PCT/JP01/02237, in fact No. 7,157,506 has no “102(e)” date. Thus, No. 7,157,506 is not only disqualified as prior art under 35 USC 103, it has no “102(e)” date and thus is not prior art.

That is, in connection with this rejection, the Examiner contends in Item 4 on page 3 of the Office Action mailed October 9, 2008, that the “effective filing date for Mizuno et al. is the 37 CFR 1.371 publication date for PCT/JP01/02237 of March 21,

2001 which antedates the Japanese priority applications date of September 30, 2002". Applicants respectfully traverse that the "effective filing date" for U.S. Patent No. 7,157,506 is the "publication date" for PCT/JP01/02237. In connection therewith, it is emphasized that No. PCT/JP01/02237 is the application number (not publication number) of the International (PCT) Application of which the U.S. application issuing as U.S. Patent No. 7,157,506 is a National Stage application under 35 USC 371, and March 21, 2001, is the filing date (not publication date) of the international application. Thus, Applicants also respectfully traverse the contention by the Examiner that March 21, 2001, is the "37 CFR 1.371 publication date for PCT/JP01/02237" (emphasis added).

In any event, it is respectfully submitted that U.S. Patent No. 7,157,506 has no 35 USC 102(e) date; that the date, for prior art purposes, of U.S. Patent No. 7,157,506, is January 2, 2007, the patenting date of this U.S. patent; and that such date of January 2, 2007, is after the effective filing date of the above-identified application which is September 29, 2003, well before the publication date of U.S. Patent No. 7,157,506. Thus, in addition to being disqualified as prior art due to 35 USC 103(c), it is emphasized that No. 7,157,506 does not qualify as prior art in connection with the above-identified application.

That U.S. Patent No. 7,157,506 has no prior art date for purposes of 35 USC 102(e) can be seen in the flowchart for 35 USC 102(e) dates on page 700-41 of the Manual of Patent Examining Procedure (MPEP). A copy of this flowchart on page 700-40 is enclosed herewith, for the convenience of the Examiner. Thus, note that in the top box, the answer is "Yes" as to whether the reference (U.S. Patent No. 7f,157,506) is a U.S. Patent of an International Application (IA); and in the left-hand box in the second row of boxes, the answer is "Yes" as to whether the IA was

filed "on or after Nov. 29, 2000". Going to the left-hand box of the third row of boxes, the answer is "No" as to whether the WIPO publication of the IA was in English; thus, notwithstanding that the IA corresponding to U.S. Patent No. 7,157,506 did designate the United States, the answer is "No" to the questions in the box in the third row. Following the "No" arrow, it can be seen in the bottom row that there is no §102(e) date, and that the U.S. Patent is prior art as of its publication date under §102(a) or (b). Clearly, this flowchart shows that U.S. Patent No. 7,157,506 is not prior art under 35 USC 102(e) (as of a filing date thereof) in connection with the above-identified application.

Moreover, the undersigned again notes that U.S. Patent No. 7,157,506 is disqualified as prior art under 35 USC 103(a). Note page 34 of the prior Amendment, submitted August 22, 2008. For this reason also, it is respectfully submitted that the rejection over U.S. Patent No. 7,157,506 must fail.

The Examiner's attention is again directed to the paragraph bridging pages 34 and 35 of the Amendment filed August 22, 2008. In any event, it is respectfully submitted that the U.S. patent, that is, U.S. Patent No. 7,157,506, does not qualify as prior art, this U.S. patent having no prior art date under 35 USC 102(e); and that, in any event, U.S. Patent No. 7,157,506 is disqualified as prior art under 35 USC 103, noting 35 USC 103(c), and particularly noting the Statement of common ownership on page 34 of the Amendment filed August 22, 2008.

Again noting that U.S. Patent No. 7,157,506 cannot qualify as prior art and/or is disqualified as prior art, no further discussion in connection with this rejection is necessary. In any event, Applicants maintain reliance on arguments made on pages 35-37 of the Amendment filed August 22, 2008, concerning differences between the presently claimed subject matter and U.S. Patent No. 7,157,506,

including unexpectedly better results achieved by the present invention, such that the presently claimed subject matter patentably distinguishes over the teachings of No. 7,157,506.

In view of the foregoing comments, reconsideration and withdrawal of the rejection under 35 USC 103(a) over U.S. Patent No. 7,157,506 to Mizuno, et al.; and further consideration of the above-identified application in light of withdrawal of such rejection and in light of the foregoing, are respectfully requested.

To the extent necessary, Applicants hereby petition for an extension of time under 37 CFR 1.136. Kindly charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Account No. 01-2135 (case 511.44961X00), and please credit any overpayments to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

By /William I. Solomon/
William I. Solomon
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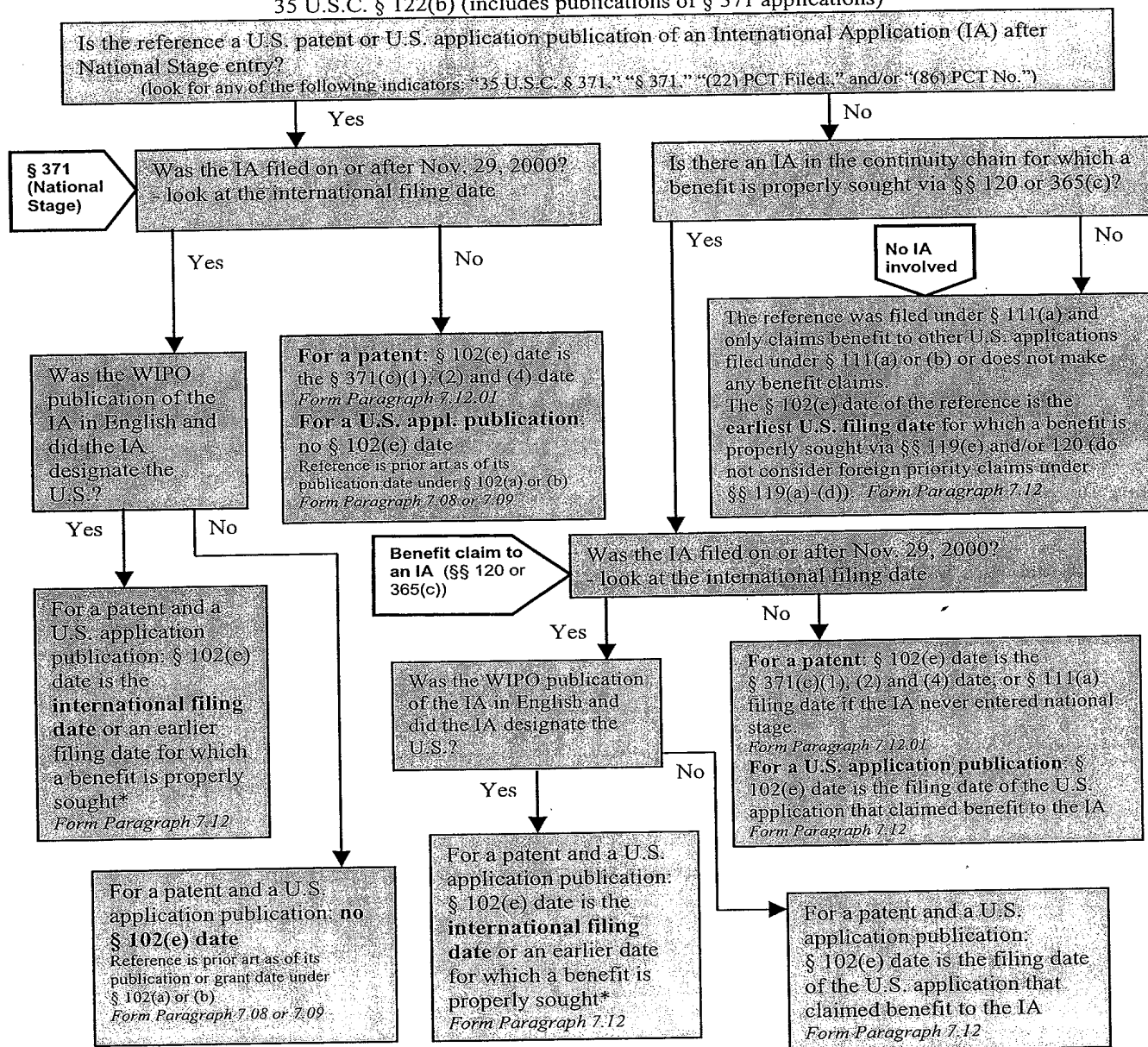
Attachment: Flowcharts (pg. 700-40)

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III. FLOWCHARTS

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FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:
Apply to all applications and patents, whenever filed
Chart I: For U.S. patent or U.S. patent application publication under
35 U.S.C. § 122(b) (includes publications of § 371 applications)



* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.